

REMARKS

In the Office Action, the Examiner objected to the disclosure because of some misspelled words. Applicants have amended the specification to correct the misspellings and respectfully request that the Examiner's objection be withdrawn. The Examiner has also objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Support for the subject matter claimed in claim 41 may be found, for example, in the second paragraph on page 16 of the specification. Applicants therefore assume that the Examiner is requiring amendment of the last paragraph in claim 41 to provide an antecedent basis for "the specific mobile scanning unit." Applicants have amended claim 41 to correct the antecedent basis as required by the Examiner and to correct various typographical errors. Thus, Applicants respectfully request that the Examiner's objection to the specification be withdrawn.

Claims 11-16 and 33-61 are pending in the present application. In the Office Action, claims 11-16, 33-37, and 41-61 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kubler, et al (U.S. Patent No. 5,726,984) in view of Buss, et al (U.S. Patent No. 5,539,395). Claims 38-40 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kubler in view of Buss and further in view of Weitzen, et al (U.S. Patent No. 5,107,259). The Examiner's rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. That is, there must be something in the prior art as a whole to suggest the desirability,

and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Third, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. A recent Federal Circuit case emphasizes that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

Moreover, it is the claimed invention, as a whole, that must be considered for purposes of determining obviousness. A mere selection of various bits and pieces of the claimed invention from various sources of prior art does not render a claimed invention obvious, unless there is a suggestion or motivation in the prior art for the claimed invention, when considered as a whole. In this case, it is respectfully submitted that the obviousness rejection is improper for many reasons. First, there is no support in the prior art of record for the Examiner's conclusory statements regarding common knowledge of persons of ordinary skill in the art. Second, even

considering all the art and statements, there is no suggestion or motivation in the prior art of record for the entirety of the claimed invention.

With regard to independent claims 11, 33, and 41, Applicants describe and claim a mobile scanning unit for use in connection with a radio data communications system. The mobile scanning unit includes a scanner for scanning optical code, a radio module for data communications, and a display. The scanner also includes an annunciator. The mobile scanning unit described and claimed in claim 11 includes a programmed controller for controlling the scanner and receiving data from the scanner. The programmed controller is programmed to receive alphanumeric paging messages using the data communications system, to provide said alphanumeric paging messages to the display, and to operate the annunciator to signal receipt of a paging message. The radio module described and claimed in claim 33 is programmed to receive alphanumeric paging messages, to provide the alphanumeric paging messages to the display, and to engage the annunciator to signal receipt of a paging message.

Kubler describes a packet-based hierarchical communications system. In particular, Kubler is directed to a method and apparatus wherein voice and data communication is provided among devices within wireless portions of a communication network and stationary devices within hardware portions of the network. In various embodiments of the invention described by Kubler, a conventional code reader may be included. However, the conventional code reader described by Kubler is not programmed to receive alphanumeric paging messages using the communications system, and Kubler provides no suggestion or motivation for modifying the conventional code reader so that it may receive alphanumeric paging messages using the communications system. At least in part because the code reader described by Kubler is not programmed to receive alphanumeric paging messages using the communications system,

Kubler also does not describe, suggest, or provide any motivation for providing alphanumeric paging messages to a display in the code reader. Furthermore, as admitted by the Examiner at paragraph 2 on page 4 of the Office Action, the code reader described by Kubler does not include an annunciator. Consequently, the code reader described by Kubler is not programmed to engage an annunciator to signal receipt of a paging message.

The Examiner relies on Buss to teach an annunciator that is used to signal receipt of a paging message. In particular, Buss is directed to providing a location dependent message to a paging device. The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used an annunciator to signal receipt of a paging message in Kubler's device, i.e. the conventional code reader, for the purpose of alerting a user of a received message. Applicants respectfully disagree for at least the following reasons. First, Buss and Kubler are both completely silent with regard to a scanner, or a code reader, that is programmed to receive alphanumeric paging messages using the communications system and therefore includes an annunciator to signal receipt of an alphanumeric paging message. Second, since Buss is concerned with providing location dependent messages to conventional paging devices, Buss provides no teaching or motivation to modify the prior art in the manner suggested by the Examiner, i.e. to modify the conventional code reader described by Kubler to receive alphanumeric paging messages using the communications system and to include an annunciator to signal receipt of an alphanumeric paging message.

With regard to dependent claims 38-40, the Examiner relies on Weitzen to teach a display which includes a first screen having a first resolution and a second screen having a second resolution, wherein the second resolution is higher than the first resolution. However, Weitzen

does not remedy the aforementioned fundamental deficiencies of the primary and secondary references.

For at least the aforementioned reasons, Applicants respectfully submit that there is no suggestion or motivation in the prior art for the claimed invention, when considered as a whole.

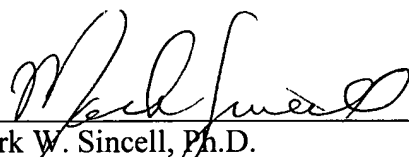
Furthermore, there is no support in the prior art of record for the Examiner's conclusory statements regarding common knowledge of persons of ordinary skill in the art. Thus, applicants respectfully submit that independent claims 11, 33, 41, and all claims depending therefrom, are not obvious over Kubler in view of Buss and, with regard to dependent claims 38-40, further in view of Weitzen.

For the aforementioned reasons, it is respectfully submitted that all claims pending in the present application are in condition for allowance. The Examiner is invited to contact the undersigned at (713) 934-4052 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

Date: _____

6/20/03



Mark W. Sincell, Ph.D.

Reg. No. 52,226

Williams Morgan & Amerson, P.C.

10333 Richmond Avenue, Suite 1100

Houston, TX 77042

(713) 934-7000

(713) 934-7011 (Fax)

AGENT FOR APPLICANTS